

REMARKS

Claims 1-8, and 11-26, are pending in the present application. In the Final Office Action mailed October 4, 2007, the Examiner rejected claims 1-3, 5-8, 11-21, and 23-26 under 35 U.S.C. §102(e) as being anticipated by Fayad et al. (US Pub 2005/0010104), hereinafter Fayad ('104). The Examiner next rejected claims 4 and 22 under 35 U.S.C. §103(a) as being unpatentable over Fayad ('104) in view of Parker et al. (Improved Efficiency in Double-Inversion Fast Spin-Echo Imaging. *Magnetic Resonance in Medicine*. 47:1017-1021. 2002) hereinafter Parker (2002), previously made of record.

The Examiner first made Fayad of record in the non-final Office Action mailed March 9, 2007; however, the Examiner did not reject any of the pending claims over Fayad. In the Final Office Action mailed October 4, 2007, the Examiner rejected all claims based at least in part on Fayad. In response thereto, Applicant filed a declaration under 37 C.F.R. §1.131 ante-dating the filing date of Fayad.

In the Advisory Action mailed January 25, 2008, the Examiner indicated that the 1.131 declaration would not be entered because, according to the Examiner, the declaration under 1.131 as set forth in MPEP §715(II) "is not permissible in instances where the reference US patent or patent publication claims the same subject matter claimed in the instant application." *Advisory Action*, p. 3.

MPEP §715(ii)(B) states that a 37 CFR 1.131 declaration is inappropriate "[w]here the reference U.S. patent or U.S. patent application publication claims the same patentable invention." However, as stated in MPEP §715.05, "[a] 37 CFR 1.131 affidavit is ineffective to overcome a United States patent or patent application publication, not only where there is a verbatim correspondence between claims of the application and of the patent, but also where there is no patentable distinction between the respective claims." Furthermore, "an interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa." *Id. (emphasis added)*. The Examiner stated that "both the instant claims and reference claims recite a method of black blood DIR imaging wherein multiple image datasets are acquired per single re-inversion pulse." *Advisory Action*, p. 3. However, Applicant respectfully disagrees with this generalization of the claims..

A review of the image file wrapper in PAIR of the Fayad reference reveals that a Notice of Allowance has now been mailed therein. In the corresponding Notice of Allowability, claim 1 was amended to read as follows:

1. A method of magnetic resonance imaging of blood vessel walls, comprising
administering a series of DIR preparation pulse modules at a repetition interval
short enough that at least two DIR preparation pulse modules occur within each RR interval;
in the interval between each DIR preparation pulse module, acquiring image data
for a plurality of slices;
repeating the data acquisition across a plurality of RR intervals to acquire images
for the plurality of slices; and
generating an output based on the images.

Applicant does not believe that the claims of the instant application and the claims of Fayad have patentably indistinct claims such that the declaration under 1.131 may not be entered.

As an example, Fayad calls for administering a series of DIR preparation pulse modules at a repetition interval short enough that at least two DIR preparation pulse modules occur within each RR interval. Fayad defines the DIR module to include “two 180-degree adiabatic hyperbolic secant RF pulses: nonselective and selective.” *Paragraph [0017] (emphasis added)*. Accordingly, Fayad calls for administering at least two nonselective RF pulses and at least two selective RF pulses in each RR interval. The claims of the instant application, however, do not call for each RR interval to include at least two nonselective RF pulses and at least two selective RF pulses. Accordingly, Applicant believes that the requirement in Fayad to have at least two DIR preparation pulse modules occurring within each RR interval does not render the claims of Fayad and the instant claims patentably indistinct. That is, Applicant believes that the requirement in the claims of Fayad that there be at least two DIR modules in each RR interval does not support two-way obviousness between the claims of Fayad and the instant claims. The Examiner, in generally stating that “both the instant claims and reference claims recite a method of black blood DIR imaging wherein multiple image datasets are acquired per single re-inversion pulse,” has not shown or made of record how the subject matter of the claims of Fayad would, if prior art, have anticipated or rendered obvious the subject matter of the instant claims and vice versa such that an interference should be declared between the instant application and Fayad.

Accordingly, since the record fails to show that the claims of the instant application and the claims of Fayad have patentably indistinct claims, Applicant believes that the declaration under 1.131 is indeed appropriate and requests reconsideration and entry thereof. As such, Fayad should no longer be available as prior art, and the rejection of claims 1-8 and 11-26 based on Fayad must be withdrawn.

Should the above arguments not be found persuasive by the Examiner to allow entry of the 1.131 declaration, then the Examiner should suggest an interference between the instant application and Fayad. *See MPEP § 2304*. “Who suggests the interference determines what must be done and shown prior to declaration of an interference.” *Id.*

37 CFR 41.202(c) states that the Examiner “may require an applicant to add a claim to provoke an interference.” The Advisory Action appears to suggest that the addition of a new claim is not needed to invoke an interference since the Examiner cited MPEP § 715(II) and since the Examiner stated that “both the instant claims and reference claims recite a method of black blood DIR imaging wherein multiple image datasets are acquired per single re-inversion pulse.” *Advisory Action*, p. 3. However, the Examiner’s statements in the Advisory Action do not make the record clear as to whether or not the Examiner believes that a new claim is actually needed. Absent such, the application and the 1.131 declaration should be allowed. That is, where Applicant does not believe the current pending claims pose an interference where the Examiner does, then it is the Examiner who is to initiate an interference.

Furthermore, according to general practices set forth in the MPEP, “when an examiner first becomes aware that a potential interference exists or any other interference issue arises during prosecution of an application, the examiner should bring the matter to the attention of an IPS in the examiner's TC.” *MPEP § 2302*. It is apparent that the Examiner has become aware that a potential interference exists because the Examiner refused to enter the 1.131 declaration. Accordingly, Applicant requests that the Examiner bring the matter to the attention of the appropriate Interference Practice Specialist.

In addition, Applicant believes that, but for the Fayad reference, the instant claims are otherwise in condition for allowance based on the art of record.

A one-month petition for extension of time is being concurrently filed herewith, and the fee therefor is being paid via EFS-WEB.

Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

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General Authorization and Extension of Time

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 07-0845. Should no proper payment be enclosed herewith, as by credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-0845. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 07-0845. Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 07-0845.

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